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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669
20350	7590	07/15/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/991,379	MASCAVAGE ET AL.
	Examiner Siegfried E. Chencinski	Art Unit 3628 <i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 April 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 112 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application) in order to obtain the benefits of the filing dates of previously filed applications; the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant has claimed the filing date benefit of US patent Application No. 09/516,209 filed on February 29, 2000 as a continuation-in-part thereof. However, at least one limitation in independent claims 1, 10 and 17, "automatically opening a new web browser window for the customer", does not appear to be in the claimed parent application's disclosure. Thus, for this limitation, the earliest effective filing date should be the filing date of the instant application, i.e. November 15, 2001.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. **Claims 1-7, 9-15 & 17-20 are rejected** under 35 U.S.C. 103(a) as being disclosed by Wilf et al (US Patent 5,899,980) in view of Fung (US PreGrant Publication 2002/0055909).

**Re. Claims 1, 10 & 17,** Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- receiving transaction information from the vendor site;
- presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window (The term "transaction detail" is an integral component Wilf's preferred term "transaction data" for approval by the customer/user. He uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a "transaction amount" is a component of this "transaction detail" as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose automatically opening a new web browser window for the customer.

However, Fung et. al disclose "automatically opening a new web browser window for the customer" (page 4, [0056], lines 16-20). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf with that of Fung to establish an automated purchasing method which includes efficient automated web based steps for validating the payment for an online transaction without exposing the customer's personal information.

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**Re. Claims 2 & 18,** Wilf discloses the method for authorizing the online purchase between the customer and the vendor site as recited in claim 1 & 17, wherein the new web browser window points away from the vendor site (Col. 2, lines 26-34).

**Re. Claims 3 & 11,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Col. 2, lines 34-47).

**Re. Claims 4 & 12,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, wherein the new web browser window overlays an existing web browser window of the vendor site (Col. 2, lines 3-5, 47-51).

**Re. Claims 5, 13 & 19,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, wherein the receiving transaction information step triggers the automatically opening step (Col. 2, lines 3-15).

**Re. Claims 6, 14 & 20,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

**Re. Claims 7 & 15,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following:

that authorization was canceled by the customer;

that authorization was rejected by a funds transfer system; and

that authorization completed normally (Col. 7, line 58 - Col. 9, line 20).

**Re. Claim 9,** Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

3. **Claims 8 & 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wilf in view of Fung, and further in view of Kolling et al (US Patent 5,920,847).

**Re. Claims 8 & 16,** neither Wilf nor Fung explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf and Fung with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction.

### ***Response to Arguments***

4. Applicant's arguments filed April 7, 2004 have been fully considered but they are not persuasive.

**a. APPLICANT'S ARGUMENTS:**

**(1) Priority Claim**

““automatically opening a new web browser window for the customer” .... is fully supported in priority application 09/516,209 filed on February 29, 2000. More specifically, page 19, lines 19-21, and page 20, lines 16-22 enable this concept”.

**(2) 35 USC § 103 Rejection**

“Fung cannot be relied upon to teach anything that is supported in the parent application filed on February 29, 2000. The rejection is believed flawed for at least this reason”.

**b. EXAMINER'S RESPONSE**

**Re. Argument (1):** The Examiner has reviewed Applicant's claim that "“automatically opening a new web browser window for the customer” .... is fully supported in priority application 09/516,209 filed on February 29, 2000, particularly on page 19, lines 19-21, and page 20, lines 16-22. The Examiner has concluded that these sections do not support this claim element concept". Re. the alleged support on page 19, this is not automatic, since it requires clicking. Re. the alleged support on page 20, the Microsoft Computer Dictionary states defines a “pop-up window” as “A window that appears when an option is selected. Typically the window appears visible until the mouse button is released” (Microsoft Computer Dictionary, Third Edition, page 372). A reasonable definition of this computer industry meaning of the term “pop-up window” does not include the “automatically opening a new web browser window”.

**Re. Argument (2):** Applicant's priority filing date remains at the actual filing date of November 15, 2001 due to a lack of support by the claimed parent application because of the lack of support, at least for the claimed element “automatically opening a new web browser window for the customer”. Therefore, the filing date of Fung of March 1, 2000 qualifies the Fung reference as legitimate prior art.

***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

January 8, 2004

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600